

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

AE ✓

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

25204-81101

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on September 26, 2005

Signature 

Typed or printed name Melody K. Gutierrez

Application Number

09/827,469

Filed

April 6, 2001

First Named Inventor

Russell

Art Unit

3621

Examiner

Backer, Firmin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 45,981

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34


Signature

Spyros J. Lazaris

Typed or printed name

213/ 896-6897

Telephone number

September 26, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 3 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants submit this Pre-Appeal Brief Request for Review on or before September 26, 2004, together with a Notice of Appeal under 37 C.F.R. §41.31, a request for a three (3)-month extension of time under 37 C.F.R. §1.136(a), and the Notice of Appeal fee under 37 C.F.R. §1.17(b).

In the most recent Final Office Action the Examiner rejected claims 1-49 as being unpatentable under 35 U.S.C. §103(a) over U.S. App. Pub. No. 2002/0052933 to Leonard et al. ("Leonard et al.") in view of U.S. Patent No. 5,323,244 to Yamaguchi ("Yamaguchi et al.") and further in view of U.S. Patent No. 6,813,709 to Benardeau ("Benardeau"). In a prior Office Action, the Examiner had rejected claims 1-49 as being unpatentable under 35 U.S.C. §103(a) over Leonard in view of Yamaguchi. In response, Applicants amended claims 1-49, resulting in the final rejection that included Benardeau under 35 U.S.C. §103(a).

Applicants respectfully submit that the Examiner has not provided any teaching, suggestion or motivation to combine the features in the cited patents to create Applicants' invention.¹ The fact that discrete elements within the claims can be found somewhere in the prior art, and "can be used" in combination, does not, without more, render the combination unpatentable.² To the contrary, where the

¹ Applicants further submit that the rejection under 35 U.S.C. §103(a) does not meet the case for obviousness under 35 U.S.C. 103(a) because Benardeau does not disclose Applicants' claims as amended. The Examiner does not explain how Benardeau teaches decryption of an encrypted license to allow access information and encryption key to be accessed. This further underscores the lack of a motivation to combine, since if the rejection does not state how the cited references specifically teach the features of Applicants' claims, it cannot disclose how one can combine Benardeau with Leonhard et al. and Yamaguchi et al. to produce the claimed invention.

² See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) ("As this court has stated, 'virtually all [inventions] are combinations of old elements.'").

rejection depends on a combination of elements from prior art references, the Examiner must identify some teaching, suggestion or motivation to combine the references.³ “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.”⁴ No proper teaching, suggestion or motivation to combine has been identified in the present case.

As the Federal Circuit has stated, “virtually all [inventions] are combinations of old elements.”⁵ Therefore an examiner may often find every element of a claimed invention in the prior art.⁶ If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.⁷ Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.⁸ Such an approach would be “an illogical and inappropriate process by which to determine patentability.”⁹

A teaching of every limitation therefore is not determinative. A motivation to combine the specific elements into the claimed invention must be identified. “To

³ See, e.g., *In re Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456.

⁴ *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

⁵ *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 U.S.P.Q. (BNA) 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 U.S.P.Q. (BNA) 8, 12 (Fed. Cir. 1983) (“Most, if not all, inventions are combinations and mostly of old elements.”).

⁶ See *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

⁷ *Id.*

⁸ *Id.*

⁹ *Id.*

prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.”¹⁰ The motivation to combine the specific elements must be specifically taught.¹¹

The Federal Circuit has also addressed the sufficiency of the reasoning provided. In *In re Sang-Su Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002), the Court reversed a finding of obviousness since there was no motivation to combine two references to result in the claimed invention. The invention was a method of displaying functions of a video display device comprising entering a picture adjustment mode having a picture menu screen if a demonstration mode is selected.¹² Reference A described a television set having a menu display by which the user can adjust various picture and audio functions.¹³ Reference B described a video game display as having a demonstration mode showing how to play the game, but it did not mention the adjustment of picture or audio features.¹⁴

¹⁰ See also *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997) (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

¹¹ See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

¹² *In re Sang-Su Lee*, 277 F.3d at 1340.

¹³ *Id.*

¹⁴ *Id.*

The Examiner of *In re Sang-Su Lee* stated that “it would have been obvious to one of ordinary skill in the art since the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial.”¹⁵ The Court, in reversing the determination of obviousness stated that the Examiner’s conclusory statements “do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief... It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[u]se that which the inventor taught against its teacher.’”¹⁶

Similar to *In re Sang-Su Lee*, the Examiner’s statement does not provide adequate motivation to combine specific elements of three different references into the single claimed invention. In discussing the motivation to combine Leonard et al. and Yamaguchi et al., the Examiner states:

“Therefore it would have been obvious to one of ordinary skill in the art at the invention was made to modify the inventive concept of Leonard et al. to include Yamaguchi et al.’s inventive concept of inhibiting production of a user-perceptible form of the selected content when conditions defined by the access information are not met **because this would have ensured [sic] that only the authorized user with specified access rights [sic] can access the content for reproduction.**” (Final Action, p. 3 lines 7-17, underline and bold emphasis added).

Similarly, in discussing the motivation to combine Leonard et al. and Yamaguchi et al., with Benardeau, the Examiner states:

¹⁵ *Id.* at 1341.

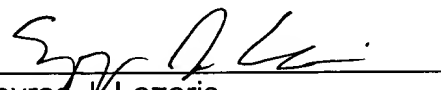
¹⁶ *Id.* at 1344 (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

"Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined inventive concept of Leonard et al and Yamaguchi et al to include Benardeau's invention concept wherein a root key for decrypting the encrypted license to allow the access information and the encryption key in the encrypted license to be accessed by the media player and security technology the media player and security technology controlling a specific media player on the user network-enabled device to produce the user-perceptible form of the selected encrypted content **because this would provide added security to the system.**" (Final Action, p. 3 line 17 – p. 4 line 11, underline and bold emphasis added.)

Similar to the general statements cited in *In re Sang-Su Lee*, at the very best, these statements may be suitable motivation **to use** the elements purportedly taught by Yamaguchi et al and Benardeau in a general sense. But, they do not provide the motivation **to combine** the specific elements of Leonhard et al. with Yamaguchi et al. and Benardeau to arrive at the presently claimed invention.

Applicants respectfully submit that in light of the above remarks, there is a clear deficiency in the prima facie case in support of the Examiner's rejections. Consequently all current claims are in condition for allowance. Applicants therefore request the withdrawal of all outstanding rejections.

Respectfully submitted,

By: 
Spyros J. Lazaris
Reg. No. 45,981

Sidley Austin Brown & Wood
555 West Fifth Street, 50th Floor
Los Angeles, California 90013-1010
Ofc: 213/ 896-6897
Fax: 213/ 896-6600
e-mail jlazaris@sidley.com
Customer No. 34492